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Filing date: **01/22/2009**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91187465
Party	Defendant LIBERTY PETROLEUM, LLC
Correspondence Address	THOMAS W. COLE ROBERTS, MLOTKOWSKI & HOBBS P.C. 7918 JONES BRANCH DR STE 500 MC LEAN, VA 22102-3366 UNITED STATES tcole@rmhlaw.com
Submission	Answer
Filer's Name	Attorney for Defendant
Filer's e-mail	tcole@rmsclaw.com
Signature	/Thomas W. Cole/
Date	01/22/2009
Attachments	AnswersToOppositions.pdf (20 pages)(469809 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Davis Industries, Inc., a Washington corporation,)

Opposer)

)

Opposition No. 91187465

v.)

Serial No. 77411015

)

Liberty Petroleum, LLC, a Virginia limited)

liability corporation,)

Applicant)

APPLICANT'S ANSWER TO NOTICE OF OPPOSITION

To the United States Patent and Trademark Office

Trademark Trial And Appeal Board

P.O.Box 1451

Alexandria, VA 22313-1451

Responses to Opposer's Allegations In Paragraphs 1-6

Liberty Petroleum, LLC (hereinafter "Applicant") a limited liability corporation of the State of Virginia, hereby respectfully answers each of numbered paragraphs 1-6 in the Notice of Opposition filed against its Application Serial Nos. 77411015, 77410925, 77410965, and 77410917 by Davis Industries, Inc. (hereinafter "Opposer") as follows:

1. Admitted.

2. Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegations contained in paragraph 2 of the Notice of Opposition and therefore denies the same.
3. Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegations contained in paragraph 3 of the Notice of Opposition and therefore denies the same.
4. Denied, inasmuch as Applicant's prior U.S. Trademark Registration Nos. 2,307,645; 2,669,918 and 2,669,919 preclude any claim by Opposer under Section 2(d) of The Lanham Act, but admitted inasmuch as the Opposer's alleged marks for its alleged services so resemble the marks of the Applicant's aforesaid registrations as to be likely to cause confusion, mistake or deception and inasmuch as Opposer's alleged marks therefore conflict with the Applicant's prior and superior rights as reflected in its aforesaid federal registrations.
5. Denied.
6. Denied.

First Affirmative Defense

1. Applicant is the owner of record in the US Trademark Office of Registration No. 2,307,665 (Exhibit 1) for LIBERTY + Design for motor oil in IC 004, Registration No. 2,669,918 (Exhibit 2) for the word mark LIBERTY for "retail and wholesale distributorship featuring petroleum fuels and lubricants" in IC 035, and Registration No. 2,669,919 (Exhibit 3) for LIBERTY + Design for "retail and wholesale distributorship featuring petroleum fuels and lubricants" in IC 035, all of which have achieved an incontestable status.

2. Under Section 33 (b) of The Lanham Act, Applicant's aforesaid registrations constitute conclusive evidence of the validity of its registered marks, of its ownership of the marks and of its exclusive right to use the registered marks in commerce. Such rights of the Applicant supersede the alleged rights claimed by Opposer in its alleged marks, thereby negating the basis for Opposer's claim.

Second Affirmative Defense

1. The mark LIBERTY + Design sought to be registered by Applicant is substantially identical in appearance and in the recitation of goods and services to LIBERTY + Design in Registration No. 2,669,919, the word mark LIBERTY in Registration No. 2,669,918, and LIBERTY + Design in Registration No. 2,307,665.
2. Opposer's claim is accordingly barred under the Morehouse Doctrine, which stands for the proposition that, where a trademark owner applies for a registration of a mark that is "substantially identical" to his previously registered mark for "substantially identical" goods or services, an opposer should not be allowed to challenge a registration when the subsequent registration will not cause the opposer to suffer any additional harm over and above any damage it may suffer from the existing registration.

Third Affirmative Defense


If and only if the Board should find that the present identification of goods in the opposed application is insufficiently specific to support the dismissal of this opposition on the basis of the evidence submitted, defenses raised and/or arguments made by the Applicant, then and only then, Applicant requests approval by the Board of an amendment to the identification of goods to read:

Petroleum products, namely hydrocarbon fuels; petroleum products, namely, motor oil; both sold through retail and wholesale distributorships operating under the mark and name LIBERTY.

Wherefore, having made full answer to the Notice of Opposition, Applicant requests that the Notice of Opposition be denied and that this action be dismissed with prejudice.

Respectfully submitted,

Date: January 22, 2009

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Customer No. 25570

Roberts Mlotkowski Safran & Cole P.C.

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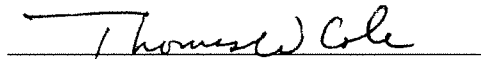
Facsimile: (703) 848 2981

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The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by facsimile or email (by agreement only) to Davis Industries' counsel, Robert J. Carlson, Christensen O'Connor Johnson Kindness PLLC located at 1420 Fifth Avenue, Suite 2800, Seattle, Washington 98101 on this date.

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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Davis Industries, Inc., a Washington corporation,)

Opposer)

)

Opposition No. 91187465

v.)

Serial No. 77410925

)

Liberty Petroleum, LLC, a Virginia limited)

liability corporation,)

Applicant)

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4. Denied, inasmuch as Applicant's prior U.S. Trademark Registration Nos. 2,307,645; 2,669,918 and 2,669,919 preclude any claim by Opposer under Section 2(d) of The Lanham Act, but admitted inasmuch as the Opposer's alleged marks for its alleged services so resemble the marks of the Applicant's aforesaid registrations as to be likely to cause confusion, mistake or deception and inasmuch as Opposer's alleged marks therefore conflict with the Applicant's prior and superior rights as reflected in its aforesaid federal registrations.
5. Denied.
6. Denied.

First Affirmative Defense

1. Applicant is the owner of record in the US Trademark Office of Registration No. 2,307,665 (Exhibit 1) for LIBERTY + Design for motor oil in IC 004, Registration No. 2,669,918 (Exhibit 2) for the word mark LIBERTY for "retail and wholesale distributorship featuring petroleum fuels and lubricants" in IC 035, and Registration No. 2,669,919 (Exhibit 3) for LIBERTY + Design for "retail and wholesale distributorship featuring petroleum fuels and lubricants" in IC 035, all of which have achieved an incontestable status.

2. Under Section 33 (b) of The Lanham Act, Applicant's aforesaid registrations constitute conclusive evidence of the validity of its registered marks, of its ownership of the marks and of its exclusive right to use the registered marks in commerce. Such rights of the Applicant supersede the alleged rights claimed by Opposer in its alleged marks, thereby negating the basis for Opposer's claim.

Second Affirmative Defense

1. The mark LIBERTY + Design sought to be registered by Applicant is substantially identical in appearance (differing only by stylization and /or a design element) and in the recitation of goods and services to the word mark LIBERTY in Registration No. 2,669,918, and LIBERTY + Design in Registration Nos. 2,307,665 and 2,669,919.
2. Opposer's claim is accordingly barred under the Morehouse Doctrine, which stands for the proposition that, where a trademark owner applies for a registration of a mark that is "substantially identical" to his previously registered mark for "substantially identical" goods or services, an opposer should not be allowed to challenge a registration when the subsequent registration will not cause the opposer to suffer any additional harm over and above any damage it may suffer from the existing registration.

Third Affirmative Defense

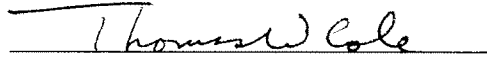
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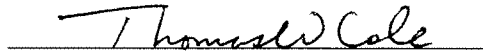
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)	Opposition No. 91187465
v.)	Serial No. 77410965
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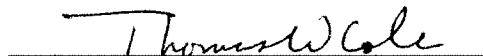
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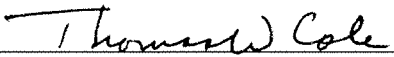
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Davis Industries, Inc., a Washington corporation,))	
Opposer)	
)	Opposition No. 91187465
v.)	Serial No. 77410917
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Second Affirmative Defense

1. The word mark LIBERTY sought to be registered by Applicant is identical in appearance the word mark LIBERTY of Registration No. 2669918, and is substantially identical in goods or services, and is further substantially identical in appearance (differing only by stylization and /or a design element) and in the recitation of goods and services to the marks LIBERTY + Design in Registration Nos. 2,307,665 and 2,669,919.
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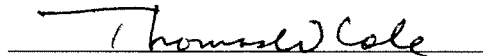
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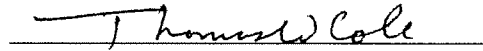
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